

REMARKS

Paragraph [0009] has been amended to correctly insert the word --Angstroms-- instead of the symbol “ \AA .” When the previous amendment was printed, the printer did not recognize the symbol and printed it out incorrectly. That same printer error occurred in the amendments to Claims 6, 12, 19, 26, 32 and 39. We have corrected that printer error.

Claims 1 through 40 are currently pending in the application.

Claims 1 through 34 stand rejected.

Claims 35-40 have been allowed.

Applicants propose to amend claims 1, 6, 8, 10, 12, 14, 15, 21, 26, 28, 30, 32, and 34, and respectfully request reconsideration of the application as proposed to be amended herein.

35 U.S.C. § 112 Claim Rejections

Claims 8 through 14 and 21 through 34 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicants respectfully traverse this rejection, as hereinafter set forth. Applicants have amended independent claims 8, 14, 21, 28, and 34 to delete the word “partially”. Applicants assert that claims 8 through 14 and 21 through 34 comply with the provisions of 35 U.S.C. § 112 and are allowable.

35 U.S.C. § 101 Double Patenting Rejection

Claims 1 through 7 and 15 through 20 stand rejected under 35 U.S.C. § 101 as claiming the same invention as that of claims 1 through 7 and 15 through 20 of prior U.S. Patent 6,699,743 B2 (hereinafter referred to as the '743 patent). Applicants respectfully traverse this rejection, as hereinafter set forth.

Applicants assert that a reliable test for statutory double patenting under 35 U.S.C. § 101 is whether a claim in the application can be literally infringed without infringing a corresponding claim in the patent. Is there an embodiment of the invention that falls within the scope of one claim, but not the other? If there is such an embodiment of the claimed invention, then identical

subject matter is not defined by both claims and statutory double patenting does not exist under 35 U.S.C. § 101. *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

Applicants assert that not statutory double patenting exists between the embodiments of the inventions of presently amended independent claims 1 and 15 of the present application and the embodiments of the inventions set forth in corresponding independent claims 1 and 15 of the '743 patent because different embodiments of the inventions are being claimed. For instance, the embodiments of the inventions set forth in presently amended independent claims 7 and 15 of the present application calls for as an element of the invention "supplying a substrate having an oxide layer over at least a portion of the substrate" whereas the embodiments of the inventions set forth in corresponding independent claims 1 and 15 of the '743 patent do not. Regarding the embodiment of the invention set forth in presently amended independent claim 15 of the present application calls for an element of the invention "

Claim/Specification Objections

Paragraph [0009] of the specification and claims 6, 12, 19, 26, 32, and 39 stand objected to because of typographical errors. Appropriate corrections have been made

ENTRY OF AMENDMENTS

The proposed amendments to claims 1, 6, 8, 10, 12, 14, 15, 21, 26, 28, 30, 32, and 34 above should be entered by the Examiner because the amendments are supported by the as-filed specification and drawings and do not add any new matter to the application to comply with the provisions of 35 U.S.C. § 132. Further, Applicants request entry of this amendment under 35 U.S.C. § 1.116 because the amendment is timely filed, the amendment places the application in condition for allowance, and the amendment does not raise new issues or require a further search. Finally, if the Examiner determines that the amendments do not place the application in condition for allowance, entry is respectfully requested upon filing of a Notice of Appeal herein.

CONCLUSION

Claims 1 through 40 are believed to be in condition for allowance, and an early notice thereof is respectfully solicited. Should the Examiner determine that additional issues remain which might be resolved by a telephone conference, he is respectfully invited to contact Applicants' undersigned attorney.

Respectfully submitted,



James R. Duzan
Registration No. 28,393
Attorney for Applicants
TRASKBRITT
P.O. Box 2550
Salt Lake City, Utah 84110-2550
Telephone: 801-532-1922

Date: October 21, 2005
JRD/ljb:lmh:csw
Document in ProLaw